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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,640	01/12/2000	DAVID ELLIOTT WHITTEN	HEM-98/644(H)	5923
24131	7590	05/05/2006	EXAMINER	
LERNER GREENBERG STEMER LLP P O BOX 2480 HOLLYWOOD, FL 33022-2480			DEXTER, CLARK F	
			ART UNIT	PAPER NUMBER
			3724	
DATE MAILED: 05/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/481,640

Applicant(s)

WHITTEN ET AL.

Examiner

Clark F. Dexter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5 and 7-13 is/are pending in the application.  
4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.  
5) ☒ Claim(s) 2,3 and 10 is/are allowed.  
6) ☒ Claim(s) 1,5,9 and 11-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 17, 2006 has been entered.

### ***Claim Objections***

2. Claim 11 is objected to because of the following informalities:

In claim 11, line 12, it seems that the comma should be deleted for clarity.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. Claims 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, last two lines, the recitation "said circumference region" lacks positive antecedent basis.

In claim 11, line 15, "said tucking blade" lacks antecedent basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Prior Art Rejections Over Halliwell:**

5. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliwell, pn 1,499,106 in view of Japanese Publication 57-131670 (hereafter JP '670)

Regarding claim 1, Halliwell discloses a cutting device with almost every structural limitation of the claimed invention including:

a rotary cutter (e.g., 7);

a transfer cylinder (e.g., 5) having a cutting ledge (e.g., 10) cooperating with said rotary cutter for cutting a ribbon into signatures having a desired cutoff length, said transfer cylinder further having a central cylinder axis, a circumferential region, a gripper (e.g., 4, 15, 16) and a tucking blade (e.g., 12) disposed in said circumferential region at a fixed distance from said central cylinder axis, and an adjustable diameter portion (e.g., 19, 20, 31, 32) disposed between said gripper and said tucking blade in said circumferential region of said transfer cylinder, said adjustable diameter portion being movable in a direction toward and away from said central cylinder axis resulting in a change in a running line distance that the ribbon runs between said tucking blade and said cutting ledge for setting the desired cutoff length of the signatures.

Further, regarding claim 5, Halliwell includes:

a cutting blade (e.g., 9) fixed to said rotary cutter and said cutting ledge disposed in said circumferential region of said transfer cylinder for cooperating with said cutting blade.

Halliwell lacks a dancer roller for compensating for variations in length of the ribbon. However, such dancer rolls are old and well known in the art and provide various well known benefits such as moderating tension of a web or for establishing a particular tension in a web handling apparatus. JP '670 discloses one example of such a dancer roll and teaches that it eliminates variations in tension of a web thereby to prevent breakage thereof. Therefore, it would have been obvious to one having ordinary skill in the art to provide a dancer roll on the cutting device of Halliwell for the well known benefits including those described above.

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Regarding claims 12 and 13, the cutting device of Halliwell appears to be fully capable of meeting the functional recitations defined therein, specifically:

wherein the running line distance can be changed up to 16.058 mm; and

wherein the running line distance can be changed up to 41.36 mm.

Claims 12 and 13 do not clearly set forth, either explicitly or implicitly, any additional structural elements with respect to claim 1, but rather appear to set forth size limitations with respect to the structural elements previously claimed. Halliwell's device, manufactured to the corresponding proportions, could clearly meet such limitations; for example, to meet claim 13, Halliwell's cutting device could be made approximately 2.5 times larger than the size of the cutting device that would meet claim 12. While it is not clear as to whether Halliwell's cutting device discloses structural elements having the size to meet the functional recitations of claims 12 and 13 (because there are no specific dimensions disclosed in Halliwell), it has been held that, absent a showing to the contrary, a mere change in size is not sufficient to patentably distinguish the claimed invention over the prior art. Thus, Neal's device could be made to virtually any scale and thus meet the limitations of claims 12 and 13.

Prior Art Rejections Over Neal et al.:

6. Claims 1, 5, 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neal et al., pn 3,477,709 in view of Halliwell, pn 1,499,106 and Japanese Publication 57-131670 (hereafter JP '670).

Regarding claims 1 and 5, Neal discloses a cutting device with almost every structural limitation of the claimed invention including:

- a rotary cutter (e.g., 3);

- a transfer cylinder (e.g., 2) cooperating with said rotary cutter for cutting a ribbon into signatures having a desired cutoff length, said transfer cylinder further having a central cylinder axis, a circumferential region, a gripper (e.g., 6) and a tucking blade (e.g., shown schematically between rollers 7, see col. 2, lines 31-34) disposed in said circumferential region at a fixed distance from said central cylinder axis, and an adjustable diameter portion (e.g., 11) disposed between said gripper and said tucking blade in said circumferential region of said transfer cylinder (e.g., at least part of 11 is disposed between the gripper and the tucking blade), said adjustable diameter portion being movable in a direction toward and away from said central cylinder axis resulting in a change in a running line distance that the ribbon runs between said tucking blade and said cutting ledge for setting the desired cutoff length of the signatures.

Regarding claim 9, Neal et al. discloses a cutting device with almost every structural limitation of the claimed invention including:

- a rotary cutter (e.g., 3);

- a transfer cylinder (e.g., 2) cooperating with said rotary cutter for cutting a ribbon into signatures having a desired cutoff length, said transfer cylinder having a central cylinder axis, a circumferential region carrying the ribbon during a cutting operation, a gripper (e.g., 6) and a tucking blade (e.g., shown schematically between rollers 7, see col. 2, lines 31-34) disposed in said circumferential region at a fixed distance from said

central cylinder axis, and an adjustable diameter portion (e.g., 11) disposed between said gripper and said tucking blade in said circumferential region of said transfer cylinder (e.g., at least part of 11 is disposed between the gripper and the tucking blade), said adjustable diameter portion being movable in a direction toward and away from said central cylinder axis for adjusting the desired cutoff length of the signatures by selectively shortening and lengthening the circumferential region carrying the ribbon by said adjustable diameter portion pressing radially outward against a part of said circumference region.

Regarding claim 11, Neal discloses a cutting device with almost every structural limitation of the claimed invention including:

- a rotary cutter (e.g., 3);

- a transfer cylinder (e.g., 2) cooperating with said rotary cutter for cutting a ribbon into signatures having a desired cutoff length, said transfer cylinder further having a central cylinder axis, a circumferential region, one of a linear jack and an eccentric jack (e.g., 17, 22), and an adjustable diameter portion (e.g., 11) disposed in said circumferential region of said transfer cylinder, said one of said linear jack and said eccentric jack being connected to said adjustable diameter portion, to move said adjustable diameter portion in a direction toward and away from said central cylinder axis resulting in a change in a running line distance that the ribbon runs between said tucking blade (e.g., shown schematically between rollers 7, see col. 2, lines 31-34) and said cutting ledge (e.g., at least part of 11 is disposed between the gripper and the tucking blade) for setting the desired cutoff length of the signatures.



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Neal lacks (a) an explicit disclosure that the transfer cylinder has a cutting ledge (claims 1 and 11), specifically a cutting ledge disposed in the circumferential region of the transfer cylinder as set forth in claim 5, and (b) a dancer roller (claims 1, 9, 11).

Regarding (a), such cutting ledges are old and well known in the art and provide various well known benefits including providing a surface against which to make a cut with a cutting knife. Halliwell discloses just one example of such a cutting ledge (e.g., 10) disposed in the circumferential region of the transfer cylinder. Therefore, it would have been obvious to one having ordinary skill in the art to provide a cutting ledge on the cutting device of Neal for the well known benefits including those described above.

Regarding (b), such dancer rolls are old and well known in the art and provide various well known benefits such as moderating tension of a web or for establishing a particular tension in a web handling apparatus. JP '670 discloses one example of such a dancer roll and teaches that it eliminates variations in tension of a web thereby to prevent breakage thereof. Therefore, it would have been obvious to one having ordinary skill in the art to provide a dancer roll on the cutting device of Neal for the well known benefits including those described above.

Regarding claims 12 and 13, the cutting device of Neal et al. appears to be fully capable of meeting the functional recitations defined therein, specifically:

wherein the running line distance can be changed up to 16.058 mm; and

wherein the running line distance can be changed up to 41.36 mm.

Claims 12 and 13 do not clearly set forth, either explicitly or implicitly, any additional structural elements with respect to claim 1, but rather appear to set forth size limitations

with respect to the structural elements previously claimed. Neal's device, manufactured to the corresponding proportions, could clearly meet such limitations; for example, to meet claim 13, Neal's cutting device could be made approximately 2.5 times larger than the size of the cutting device that would meet claim 12. While it is not clear as to whether Neal's cutting device discloses structural elements having the size to meet the functional recitations of claims 12 and 13 (because there are no specific dimensions disclosed in Neal), it has been held that, absent a showing to the contrary, a mere change in size is not sufficient to patentably distinguish the claimed invention over the prior art. Thus, Neal's device could be made to virtually any scale and thus meet the limitations of claims 12 and 13.

Prior Art Rejections Over Johansen:

7. Claims 1, 5, 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen, pn 1,821,713 in view of Halliwell, pn 1,499,106 and Japanese Publication 57-131670 (hereafter JP '670).

Regarding claims 1 and 5, Johansen discloses a cutting device with almost every structural limitation of the claimed invention including:

a rotary cutter (e.g., 6);

a transfer cylinder (e.g., 5) cooperating with said rotary cutter for cutting a ribbon into signatures having a desired cutoff length, said transfer cylinder further having a central cylinder axis, a circumferential region, a gripper (e.g., 9) and a tucking blade

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(e.g., 14) disposed in said circumferential region at a fixed distance from said central cylinder axis, and an adjustable diameter portion (e.g., 13) disposed between said gripper and said tucking blade in said circumferential region of said transfer cylinder (e.g., at least part of 13 is disposed between the gripper and the tucking blade), said adjustable diameter portion being movable in a direction toward and away from said central cylinder axis resulting in a change in a running line distance that the ribbon runs between said tucking blade and said cutting ledge for setting the desired cutoff length of the signatures (it is noted that no additional structure is clearly implied by this functional limitation and thus the device of Johansen is fully capable of performing the recited function).

Regarding claim 9, Johansen discloses a cutting device with almost every structural limitation of the claimed invention including:

- a rotary cutter (e.g., 6);

- a transfer cylinder (e.g., 5) cooperating with said rotary cutter for cutting a ribbon into signatures having a desired cutoff length, said transfer cylinder having a central cylinder axis, a circumferential region carrying the ribbon during a cutting operation, a gripper (e.g., 9) and a tucking blade (e.g., 14) disposed in said circumferential region at a fixed distance from said central cylinder axis, and an adjustable diameter portion (e.g., 13) disposed between said gripper and said tucking blade in said circumferential region of said transfer cylinder (e.g., at least part of 13 is disposed between the gripper and the tucking blade), said adjustable diameter portion being movable in a direction toward and away from said central cylinder axis for adjusting the desired cutoff length of the

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signatures by selectively shortening and lengthening the circumferential region carrying the ribbon by said adjustable diameter portion pressing radially outward against a part of said circumference region.

Regarding claim 11, Neal discloses a cutting device with almost every structural limitation of the claimed invention including:

a rotary cutter (e.g., 6);

a transfer cylinder (e.g., 5) cooperating with said rotary cutter for cutting a ribbon into signatures having a desired cutoff length, said transfer cylinder further having a central cylinder axis, a circumferential region, one of a linear jack and an eccentric jack (e.g., including 21), and an adjustable diameter portion (e.g., 13) disposed in said circumferential region of said transfer cylinder, said one of said linear jack and said eccentric jack being connected to said adjustable diameter portion, to move said adjustable diameter portion in a direction toward and away from said central cylinder axis resulting in a change in a running line distance that the ribbon runs between said tucking blade (e.g., 14) and said cutting ledge (e.g., at least part of 13 is disposed between the gripper and the tucking blade) for setting the desired cutoff length of the signatures.

Johansen lacks (a) a cutting ledge (claims 1 and 11), specifically a cutting ledge disposed in the circumferential region of the transfer cylinder as set forth in claim 5, and (b) a dancer roller (claims 1, 9, 11).

Regarding (a), such cutting ledges are old and well known in the art and provide various well known benefits including providing a rigid surface against which to make a

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cut with a cutting knife, particularly when desiring certain cutting characteristics.

Halliwell discloses just one example of such a cutting ledge (e.g., 10) disposed in the circumferential region of the transfer cylinder. Therefore, it would have been obvious to one having ordinary skill in the art to replace the rubber members 12 with cutting ledges on the cutting device of Neal for the well known benefits including those described above.

Regarding (b), such dancer rolls are old and well known in the art and provide various well known benefits such as moderating tension of a web or for establishing a particular tension in a web handling apparatus. JP '670 discloses one example of such a dancer roll and teaches that it eliminates variations in tension of a web thereby to prevent breakage thereof. Therefore, it would have been obvious to one having ordinary skill in the art to provide a dancer roll on the cutting device of Neal for the well known benefits including those described above.

Regarding claims 12 and 13, the cutting device of Johansen appears to be fully capable of meeting the functional recitations defined therein, specifically:

wherein the running line distance can be changed up to 16.058 mm; and

wherein the running line distance can be changed up to 41.36 mm.

Claims 12 and 13 do not clearly set forth, either explicitly or implicitly, any additional structural elements with respect to claim 1, but rather appear to set forth size limitations with respect to the structural elements previously claimed. Johansen's device, manufactured to the corresponding proportions, could clearly meet such limitations; for example, to meet claim 13, Johansen's cutting device could be made approximately 2.5

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times larger than the size of the cutting device that would meet claim 12. While is it not clear as to whether Johansen's cutting device discloses structural elements having the size to meet the functional recitations of claims 12 and 13 (because there are no specific dimensions disclosed in Johansen), it has been held that, absent a showing to the contrary, a mere change in size is not sufficient to patentably distinguish the claimed invention over the prior art. Thus, Johansen's device could be made to virtually any scale and thus meet the limitations of claims 12 and 13.

### ***Response to Arguments***

8. Applicant's arguments filed April 17, 2006 have been fully considered but they are not persuasive.

In the last paragraph on page 10 of the response, applicant states that:

"applicant has amended claims 1 and 11 of the instant application to recite that the adjustable diameter portion is movable a direction toward and away from the central cylinder axis resulting in a change in a running line distance that the ribbon runs between the tucking blade and the cutting ledge for setting the desired cutoff length of the signatures. In addition, claim 9 of the instant application recites that the adjustable diameter portion presses radially outward against a part of the circumference region."

Applicant then argues that:

"In Halliwell, the adjustable diameter portion, yielding blocks, 19, 20, 31 32 do not change the running line distance that the ribbon runs between the tucking blade and the cutting ledge. Simply put, the yielding blocks 19, 20, 31, 32 hold the signatures and compensate for variations in the thickness of the signatures noted that the yielding blocks themselves may expand out, but this does not affect the signature cut size (e.g. running line distance). In addition, the yielding blocks do not press in a radially outward manner against a part of the circumference region.

The Examiner respectfully disagrees with applicant's analysis. Applicant argues that the applied prior art, specifically Halliwell, does not perform the same function as the claimed invention. However, it is respectfully submitted that applicant has not described any structure, either explicitly set forth in the claim or implied, that is not present in Halliwell. Thus, if there is no structural difference between the claimed invention and the prior art (that is, other than those differences that are determined to be obvious), then the claimed invention cannot be considered to distinguish over the prior art. In other words, applicant has argued that the prior art cannot perform the recited functions, but has not described what structural difference(s) are present to distinguish the claimed invention over the prior art.

It is respectfully submitted that applicant's arguments in the first two paragraphs on page 12 cannot be considered to be persuasive for substantially the same reasons as those described above.

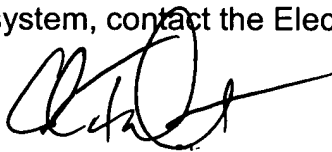
**Remarks**

9. Applicant is invited to contact the Examiner to discuss any outstanding issues and to explore possible amendments to obviate the prior art rejections and/or to place the application in condition for allowance.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**